

Application No.: 10/676,263

Amendments to the Drawings:

Figures 9(a) and 9(b) have been amended to delete reference number 48 and to show structural detail 40 to maintain consistency with the specification, as in the attached Replacement Sheet.

REMARKS

This Amendment is filed in response to the Office Action dated September 8, 2005. This application should be allowed and the case passed to issue. No new matter is raised by this amendment. The amendment to the specification and drawings correct informalities noted by the Examiner and are supported throughout the specification. The amendment to claim 1 is supported throughout the specification, the accompanying figures, and claim 3.

Claims 1, 2, and 4-22 are pending in this application. Claims 11-22 have been withdrawn, pursuant to a restriction requirement. Claims 1-10 have been rejected. Claim 1 is amended. Claim 3 is canceled.

Interview Summary

Examiner Venci is thanked for the courtesy of granting a telephone interview with the undersigned on December 7, 2005. During the interview, amendments to overcome the objections to the specification, objections to the drawings, and the indefiniteness rejections were discussed. The Examiner indicated that the amendments would be considered upon the filing of a written response.

Specification

The amendment filed July 1, 2005, was objected to as allegedly containing new matter. Though it is believed that the amendment filed July 1, 2005, does not introduce any new matter, in order to advance prosecution, the specification and drawings have been amended to address the Examiner's objection.

The specification and abstract were objected to for a number of informalities. The Examiner asserted that the phrase "is acted" is grammatically awkward, and that the paragraphs beginning at page 5, line 18 and page 7, line 20 were grammatically awkward due to the

existence of multiple comma splices and conjunctions. These objections are traversed, and reconsideration and withdrawal thereof respectfully requested.

The specification and abstract have been amended to change the phrase "on which a dynamic effect is acted on" to --wherein a dynamic effect acts on the second region--. The paragraphs beginning at page 5, line 18 and page 7, line 20 have been amended to remove the multiple comma splices and conjunctions.

Drawings

The drawings are objected to because the reference characters 1 and 11 are both allegedly used to designate "sampling element." This objection is traversed, and reconsideration and withdrawal thereof respectfully requested. As disclosed on page 15 of the specification, reference number 11 designates a capillary tube, not a sampling element, and reference number 1 designates a sampling element. Reference numbers 1 and 11 are consistently used in Figs. 1 and 2. If the Examiner maintains this rejection, it is requested that the Examiner specifically point out where in the specification reference number 11 is described as a "sampling element."

Figure 9 has been amended to change the reference number for the handling device from 48 to 40 to maintain consistency with the specification.

Applicants submit that the drawings comport with the requirements of 37 C.F.R. § 1.84.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserted that "dynamic effect" in claim 1 lacks antecedent basis and that the term is indefinite. In addition, the Examiner averred that it is not clear how the dynamic effect occurs, whether/how the dynamic effect is acted on, and that "is acted on" is grammatically awkward. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claim 1 has been amended to clarify the verb tenses. There is proper antecedent basis for the claim terms. "A dynamic effect" does not require antecedent basis. "A dynamic effect" provides the antecedent basis for a subsequently recited "the dynamic effect." When considered in light of the specification, it is clear to one of ordinary skill in this art what causes the dynamic effect. Furthermore, claim 1 has been amended to recite that a change in a magnetic field causes the dynamic effect. In view of the claim amendment, claim 1 is grammatically proper and clear.

The Examiner rejected claim 5 because "or both a1 and b1" is allegedly indefinite and grammatically awkward. Claim 5, however, is definite. It is clear that clear that the analyte sampling element can retain a1, b1, or both a1 and b1. Applicants submit that the claims comport with the requirements of 35 U.S.C. § 112.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kellogg et al. (U.S. Pat. No. 6,632,399). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the invention as claimed and the cited prior art.

An aspect of the invention, per claim 1, is an analyte sampling element comprising a first region capable of quantitatively collecting and temporarily retaining an analyte. A magnetic second region is adjacent and connected to the first region. A dynamic effect acts on the second region from outside of the second region to move the first region. The dynamic effect is caused by a change in a magnetic field.

The Examiner asserted that Kellogg et al. disclose an analyte sampling element comprising a first region capable of collecting and retaining a sample (metering capillary 702)

and a magnetic second region (electromechanical means) on which a dynamic effect (torque) acts to move the first region.

Kellog et al., however, does not anticipate claim 1 because Kellog et al. do not disclose the magnetic second region is **adjacent and connected** to the first region. Kellog et al. do not disclose that its electromechanical means are adjacent and connected to the metering capillary.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Kellogg et al. do not disclose the claimed analyte sampling element comprising a magnetic second region, adjacent and connected to the first region, wherein a dynamic effect acts on the second region from outside of the second region to move the first region, as required by claim 1, Kellogg et al. do not anticipate claim 1.

Applicants further submit that Kellogg et al. do not suggest the claimed analyte sampling element.

The dependent claims are allowable for at least the same reasons as the respective independent claims from which they depend and further distinguish the claimed analyte sampling element.

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this

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Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Bernard P. Codd

Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:MWE
Facsimile: 202.756.8087
Date: December 8, 2005

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as our correspondence address.**